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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,022	11/01/2000	David Roy Kendall	TS-7568 (US)	2088
7390 Kimbley L Muller Shell Oil Company Intellectual Property PO Box 2463 Houston, TX 77252-2463	07/16/2002			
			EXAMINER	
			TOOMER, CEPHIA D	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 07/16/2002				7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/704,022	Applicant(s) KENDALL, DAVID ROY
	Examiner Cephia D. Toomer	Art Unit 1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extension of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
 - 2a) This action is **FINAL**. 2b) This action is non-final.
 - 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- Disposition of Claims**
- 4) Claim(s) 1-22 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 - 5) Claim(s) _____ is/are allowed.
 - 6) Claim(s) 1-22 is/are rejected.
 - 7) Claim(s) _____ is/are objected to.
 - 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

- 4) Interview Summary (PTO-413) Paper No(s). _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

This Office action is in response to the amendment filed April 22, 2002 in which claims 1, 2, 7, 9, 13, 15, 18 and 20 were amended.

The rejection of the claims under 35 USC 112, second paragraph is withdrawn in view of the amendment to the claims.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuentes-Afflick (6,203,584) for the reasons of record.

Applicant argues that Fuentes-Afflick does not teach the combination of hydrocarbyl amine and polyoxyalkylene carbamate in the claimed ratio. Applicant argues that the present invention is not a combination of two compositions useful for the same purpose because Fuentes-Afflick is directed to friction reduction whereas the present invention is directed to storage stability.

The reason or motivation to modify a reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Applicant. Fuentes-Afflick teaches that more than one amine may be used and the amines taught by Fuentes-Afflick encompass those of the present invention. While it is true that Fuentes-Afflick does not teach the claimed ratio of

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aminocarbamate to hydrocarbyl amine, his teaching of at least one amine compound clearly suggests at least a ratio of 1:1 of the two amine compounds.

3. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO9112303 for the reasons of record.

Applicant argues that WO teaches away from the use of high molecular weight hydrocarbyl amines because such compounds create precipitation problems. Applicant uses such compounds to impart stability to the fuel. Applicant argues that *Titanium Metals Corp. v. Banner* 778 F.2d 775 (Fed. Cir 1985) does not apply because while the lower end of the molecular weight ranges may overlap there is nothing in WO to suggest using the higher molecular weight amines.

The examiner agrees that WO does not wish to use the high molecular weight amines because of the precipitation problem caused by the compounds. However, the fact remains that WO does teach that the amines may have a molecular weight of up to about 700, which clearly reads on the instantly claimed molecular weight of 750. Therefore, the amines would provide the intake deposit control desired by WO as well as provide stability to the fuel, as desired by Applicant.

The data have been considered and are not deemed to constitute unexpected results. The showings are not commensurate in scope with the claims. Applicant is claiming a hydrocarbyl polyoxyalkylene aminocarbamate having a M_n of 600-10,000, but exemplifies compounds that have a M_n of 1400-1800. The hydrocarbyl amines of the present invention have a M_n of 750-6000, but only a PIBA having a molecular weight of 1000 is exemplified. Also, the ratio of the aminocarbamate to hydrocarbyl amine is 1:1,

3:1; or 1:3. Applicant is claiming a much broader range. It cannot be ascertained if the alleged unexpected results are indeed unexpected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Cephia D. Toomer
Primary Examiner
Art Unit 1714

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July 12, 2002